

REMARKS

Claims 1-18 were presented for examination. Claims 1-18 were rejected. Applicant is hereby amending claims 8, 16 and 18 and adding new independent claim 19. Support for the claim amendments is found in the specification as originally filed. Reconsideration of this application as amended, and allowance of all pending claims are hereby respectfully requested.

Initially, Applicant respectfully requests the Examiner's acknowledgement of Applicant's claim for foreign priority under 35 U.S.C. § 119. Acknowledgement of the priority claim and receipt of the certified copies are respectfully solicited. Certified copies of the priority documents (JP 2002-318766 and JP 2002-318767) were filed together with the application. A stamped acknowledgement postcard, along with a copy of Applicant's priority claim and cover pages of each priority document accompany this Amendment.

Rejection under 35 U.S.C. § 102

Claims 1-3, 6-16 and 18 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,287,252 (Lugo). Applicant respectfully requests reconsideration and allowance of the claims in view of the amendments presented herein and the following arguments. For at least the reasons stated below, Lugo does not disclose or suggest each and every element of the claimed inventions.

Applicant stresses that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed

inventions and the monitoring system and method disclosed by Lugo that would preclude the factual determination that Lugo identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Lugo discloses a system for remotely monitoring physiological data (e.g., electrocardiogram information) obtained from sensors disposed on the patient. In Lugo, a patch 40 inductively couples over a short distance to the communications module 50. The patch 40 collects information from sensors, and the communications module 50 provides the higher power radio frequency (RF) link to the central monitoring station 60 (*See* Lugo at FIGS. 1-2 and col. 6, lines 38-47).

In contrast to the Examiner's assertion, Lugo fails to disclose or suggest the structural components of the portable electrocardiograph recited in independent claim 1. In particular, Lugo fails to teach or suggest "a stacked-layered circuit board" having "a plurality of circuit boards and a ground conductor layer provided between any ones of said plurality of circuit boards" as recited in claim 1. Lugo's use of a physically separate patch 40 and communications module 50 does not anticipate or render obvious the claimed use of a stacked circuit board and ground plane. As such, Lugo lacks the claimed structure and the Examiner has ignored the express elements recited in the claims. It is legally erroneous to ignore any claim limitation. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Moreover, independent claims 8 and 18, as well as new independent claim 19 are free from the applied art. Independent claim 8 describes, in pertinent part, an electrocardiogram monitoring system wherein the portable electrocardiograph housing includes a stacked-layered circuit board having a plurality of circuit boards and a ground conductor layer provided between any one of the plurality of circuit boards. Applicant submits that Lugo fails to disclose or

suggest a stacked-layered circuit board having a plurality of circuit boards and a ground conductor layer provided between any ones of the plurality of circuit boards as recited in claim 8.

With respect to independent claim 18, Lugo fails to disclose or remotely suggest “a portable electrocardiograph integrally housing an electrocardiogram measurement device and a public network communication device” as recited in independent claim 18. Indeed, the present claimed public network communication device is patentably distinct over Lugo’s patch 40, which can only transmit over short distances. Accordingly, Lugo fails to identically disclose every limitation of independent claim 18.

New added claim 19 describes, *inter alia*, an electrocardiogram monitoring method comprising the step of operating a portable electrocardiograph integrally housing an electrocardiogram measurement device and a public network communication device while housing a stacked-layered circuit board having a plurality of circuit boards and a ground conductor layer provided between any one of the plurality of circuit boards. As indicated above, Lugo fails to disclose or suggest a stacked-layered circuit board having a plurality of circuit boards and a ground conductor layer provided between any ones of the plurality of circuit boards. Moreover, Lugo fails to disclose or suggest a public network communication device and instead, only discloses a patch 40, which transmits over short distances and cannot be considered a public network communication device.

Rejection under 35 U.S.C. § 103

Dependent claims 4-5 and 17 have been rejected under 35 U.S.C. § 103 as being unpatentable over Lugo in view of U.S. Patent No. 6,28,441 hereinafter (Raymond). The Office Action relies on Raymond for the disclosure of the accelerometer and corresponding use of the

acceleration data. Applicant respectfully requests reconsideration and allowance of the claims in view of the amendments presented herein and the following arguments.

Applicant incorporates herein the arguments previously advanced in traversal of the rejection of claims 1-3, 6-16 and 18 under 35 U.S.C. § 102(b) predicated upon Lugo. The secondary reference to Raymond does not cure the argued deficiencies of Lugo. Thus, even if the applied references are combined as suggested by the Examiner, and Applicant does not agree that the requisite realistic motivation has been established, the claimed invention will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Accordingly, dependent claims 4-5 and 17 are free from the applied art.

Conclusion

Accordingly, it is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

Application No.: 10/695,442

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck

Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 REB:BKS:idw
Facsimile: 202.756.8087
Date: September 6, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**